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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,503	01/11/2007	Henry David Langer	HLBB-P01-001	9620
56679 7590 09/24/2010 GOSZ AND PARTNERS LLP ONE STATE STREET BOSTON, MA 02109			EXAMINER PAINTER, BRANON C	
			ART UNIT 3635	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/577,503	<b>Applicant(s)</b> LANGER ET AL.	
	<b>Examiner</b> BRANON C. PAINTER	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

2. The references cited in the Search Report submitted 04/26/06 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

***Claim Objections***

3. Claims 35-54, 56, 59, and 60 are objected to because of the following informalities:
  - a. Claims 35-53, "A method as." For the purpose of this examination, the examiner presumes this should read "A method of forming a barrier as."
  - b. Claims 35 and 56, "airbrick." For the purpose of this examination, the examiner presumes this should read "air brick."
  - c. Claims 38, 47, and 59, "and/or." For the purpose of this examination, the examiner presumes this should read "or."

- d. Claim 41, "or a." For the purpose of this examination, the examiner presumes this should read "or is a."
- e. Claims 42 and 54 (several times), "the pad" or "self-adherent pad". These terms lack antecedent basis. For the purpose of this examination, the examiner presumes this should read "the sealant material."
- f. Claim 60 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). **Accordingly, the claim has not been further treated on the merits.**
- g. Appropriate correction is required for all preceding objections.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 34-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claims 34 and 55, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
7. Claim 51 is rendered indefinite by the terms "EPR", "SBR", "SIS", "SBS", and "SEBS". Acronyms such as this are not acceptable claim language, since their

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meaning is ambiguous both in that acronyms may have more than one meaning (for example, ABC stands for both American Broadcasting Company and Alcoholic Beverage Control), and in that an acronym's meaning may change over time. To overcome this rejection the terms above should be fully spelled out.

8. Claims 35-54 and 56-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for depending from an indefinite claim.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. The U.S. Supreme Court supplied seven rationales in *KSR International v. Teleflex Inc.*, 550 USPQ2d 1385, that, by following the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), establish a *prima facie* case of obviousness:

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- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of a known technique to improve similar devices, methods, or products in the same way;
- (d) Applying a known technique to a known device, method, or product ready for improvement to yield predictable results;
- (e) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (f) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (g) Some teaching, suggestion, or motivation to combine prior art references that would have led one of ordinary skill to modify the prior reference teachings to arrive at the claimed invention.

12. The Examiner notes that above rationales are merely exemplary. For more information, see MPEP § 2141.

13. **Claims 34-47 and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bushberger (6,546,679) in view of Freeman (GB 2,359,843).**

14. Regarding claims 34-37 and 55-58:

- a. Bushberger discloses a self-adherent sealant material (10, Fig. 2) forming a barrier in a sub-floor environment (Fig. 1).
- b. Bushberger does not expressly disclose that the material is adhered over an external surface of a sub-floor ventilator.
- c. Freeman discloses that it is well-known to provide barriers over air bricks in building walls [claims 35, 56], with the barrier covering an external surface of the air brick periphery [claims 36, 57], as well as the building material immediately surrounding the periphery [claims 37, 58] (Abstract; Figs. 8, 9) in order to prevent the entrance of flood water.
- d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to apply the sub-floor sealant barrier of Bushberger

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over an air brick and surrounding building members as taught by Freeman, in order to prevent flood water from entering through the air brick (p. 1, [0002]).

e. The examiner notes the motivation to combine the references set forth in Freeman (p. 1, [0002]).

15. Regarding claims 38 and 59, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Freeman further disclosing brickwork or mortar adjacent the air brick periphery (Fig. 8).
16. Regarding claim 39, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a removable layer (42, Fig. 2).
17. Regarding claim 40 and 42, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a flexible, resiliently pliable sealant material (10; c. 3, 36-38).
18. Regarding claim 41, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a roll of sealant material (c. 3, 36-38).
19. Regarding claim 43 and 44, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a composite laminate of at least two layers (36, 38, 40, 42).
20. Regarding claim 45, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing one layer of separable release liner (42).

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21. Regarding claim 46, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a laminate including a backing substrate (36, 38) and an adhesive (40).

22. Regarding claim 47, Bushberger/Freeman as modified above discloses a sealant adhered over an air brick, with Bushberger further disclosing a backing substrate of waterproof (36; c. 3, 39-40) fabric (38; c. 3, 47-48) material.

23. Regarding claims 34-47 and 54, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

24. The examiner notes that, while claim 60 is not suitable for further treatment for the reasons set forth above, the combination of Bushberger/Freeman clearly meet the limitations of both claims 55 and 39, which are the only limitations of claim 60. It follows that, were the claim proper for examination, its limitations would also be met by this combination.

**25. Claims 47-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bushberger/Freeman as applied to claims 34-47 and 55-59 above, and further in view of Tahara et al. (2004/0242775).**

26. Regarding claim 47:

- a. Bushberger/Freeman discloses a sealant adhered over an air brick, with Bushberger further disclosing a backing substrate of waterproof (36; c. 3, 39-40) fabric (38; c. 3, 47-48) material.



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b. Bushberger does not expressly disclose a backing substrate of waterproof plastics film or metal foil.

c. Tahara discloses that waterproof plastics films, metal foil, and waterproof fabric materials are all equivalent structures known in the art ([0081]).

Therefore, because these backing substrate types were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the waterproof plastics films or metal foil of Tahara for the waterproof fabric of Bushberger.

d. The examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

27. Regarding claim 48, Bushberger/Freeman/Tahara as modified above discloses a sealant with variable backing adhered over an air brick, with Tahara further disclosing a waterproof plastics film of polyethylene film ([0081]).

28. Regarding claim 49, Bushberger/Freeman/Tahara as modified above discloses a sealant with variable backing adhered over an air brick, with Tahara further disclosing a metal foil of aluminum ([0081]).

29. Regarding claim 50, Bushberger/Freeman/Tahara as modified above discloses a sealant with variable backing adhered over an air brick, with Tahara further disclosing a waterproof fabric of polyester non-woven fabric ([0081]).

30. Regarding claims 51 and 52:

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- a. Bushberger/Freeman/Tahara discloses a sealant with variable backing adhered over an air brick, with Bushberger further disclosing a self-adhesive coating (40; c. 3, 55-56).
- b. Bushberger does not expressly disclose the particulars of the adhesive.
- c. Tahara discloses that adhesives for surface-protective tapes ([0002]) can be made of natural rubber ([0074]) [claim 51] and may include tackifying resins ([0067]) [claim 52].
- d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the adhesive of Bushberger by making it from natural rubber and tackifying resin as taught by Tahara, in order to provide an equivalent and well-known adhesive material for the sealant and to strengthen the adhesive properties of the sealant.
- e. The examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

31. Regarding claims 47-52, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

32. **Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bushberger/Freeman as applied to claims 34-47 and 55-59 above, and further in view of Traxler (6,453,628).**

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- a. Bushberger/Freeman discloses a sealant adhered over an air brick as set forth above, with Bushberger further disclosing a protective release liner (42).
  - b. Bushberger does not expressly disclose that the liner is made of polyester.
  - c. Traxler discloses a release liner for a building waterproofing membrane that is made of polyester (Abstract).
  - d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the liner of Bushberger by making it of polyester as taught by Traxler, in order to provide a liner of common and well-known material.
  - e. The examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
33. Regarding claims 53, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

### **Conclusion**

34. The cited patents listed on the included form PTO-892 further show the state of the art with respect to barriers in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is

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(571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rich Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Branon Painter  
Examiner  
Art Unit 3633

/Basil Katcheves/  
Primary Examiner, Art Unit 3635